

## REMARKS

### 1. Claims 1-2, 4-6 and 24-25 Are Not Anticipated By The '978 Patent:

Independent claim 1 recites a heat and pressure consolidated laminate that comprises in superimposed relationship: a) a core layer containing at least one cellulosic sheet impregnated with a thermosetting resin; and b) a first decorative layer consisting essentially of a leather material.

In the Office Action of 11/2/2006, the Examiner indicates that the '978 Patent discloses "a high pressure laminate comprising core sheets, a decorative print sheets (sic), and overlay sheets. The core sheets are made of paper and impregnated with phenolic resin. The decorative print sheet and the overlay sheets are cellulosic and impregnated with melamine resin. The decorative sheet can be a simulated leather. (See Figs 1-2; col. 1, ln. 24-35; col. 2, ln. 36-46; col. 3, ln. 20-50; Examples 1-2; claims 1-2)." (page 3, 11/2/2006 office action). In response to the applicants arguments, the Examiner indicates that "the claim language does not exclude the leather material to be simulated". (page 5, 11/2/2006 office action) Applicants respectfully disagree with the Examiner's characterization of the '978 Patent, and the rejection based thereon.

Case law<sup>1</sup> dictates that the classic test for anticipation, under 35 U.S.C. §102(b), requires that every limitation in a claim must be present in a single source reference for that reference to "anticipate" the claimed invention. The '978 Patent cannot anticipate claim 1 because the '978 Patent does not disclose "a first decorative layer consisting essentially of a leather material" as is recited in claim 1.

The '978 Patent discloses a laminate including a print sheet comprising a cellulosic sheet and a pattern that provides an appearance that simulates leather.<sup>2</sup> This print sheet is not actual leather material, as called for in claim 1. In fact, the '978 Patent teaches away from using a leather material: "With the rising cost of natural products, such as wood and leather, it has become even more desirable to provide irregularly surfaced high pressure laminates which simulate these natural products."<sup>3</sup>

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<sup>1</sup> See generally Chisum, Patents, §§3.02, 3.02[1]. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379, 231 USPQ 81, 90 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987) ("It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention, and that such a determination is one of fact."); In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) ("It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim, and that anticipation is a fact question subject to review under the clearly erroneous standard.").

<sup>2</sup> See Col. 2, lines 43-46; Col. 3, lines 20-28.

<sup>3</sup> See Col. 1, lines 50-53.

As stated above, claim 1 recites a heat and pressure consolidated laminate that includes a first decorative layer consisting essentially of a leather material. The present application defines the term "leather" as being an "animal hide".<sup>4</sup> MPEP §2111.01 (I) clearly states that "the words of a claim must be given their 'plain meaning' unless they are defined within the specification".<sup>5</sup> Such is the case here.

The significance of the definition of the term "leather" provided in the specification is considerable. The present application details: 1) the desirability of using a leather material with cabinetry and/or furniture (e.g., perception of quality, texture, smell, etc.);<sup>6</sup> 2) the disadvantages of historical applications where leather was utilized in furniture and/or cabinetry (e.g., difficult to attach, shrinkage and peel after attachment, limitations in size, etc.);<sup>7</sup> and 3) the advantages of the present invention (e.g., textures, resistant to shrinkage, smell of leather, etc.).<sup>8</sup> These distinctions illustrate well that a laminate that includes a "leather material" is clearly distinguishable from the prior art, including a high pressure laminate with a print sheet having a visual appearance intended to "simulate" leather.

In addition, the stated objects of the '978 Patent further illustrate the differences between the laminate of claim 1, and that disclosed within the '978 Patent. The objects of the '978 Patent include "to obviate or reduce the deficiencies of the prior art, such as that indicated above"; i.e., "the rising cost of natural products, such as wood and leather".<sup>9</sup> These stated objects are not satisfied by a laminate that utilizes a leather material.

In light of the foregoing, it is respectfully submitted that the rejection of claims 1, 2, and 4-6 is not valid and it is respectfully requested that the aforesaid rejection be withdrawn and the claims allowed.

The Office Action of 11/2/2006 also rejects claims 24 and 25 under 35 U.S.C. §102(b) as being anticipated by the '978 Patent. Claims 24 and 25 depend from independent claim 7, which is not rejected as being anticipated by the '978 Patent within the 11/2/2006 Office Action. Applicants respectfully request clarification regarding the rejection of claims 24 and 25 and the status of claim 7.

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<sup>4</sup> See paragraph 0017.

<sup>5</sup> See also *In re Alex Zletz*, 893 F.2d 319, 321 (CAFC 1989)

<sup>6</sup> For example, see paragraphs 0002 and 0009.

<sup>7</sup> For example, see paragraphs 0005 – 0009.

<sup>8</sup> See paragraphs 0005 – 0009.

<sup>9</sup> Col. 2, lines 5-11.

2. Claims 1-6 Are Not Anticipated By The '537 Patent:

Independent claim 1 recites a heat and pressure consolidated laminate that comprises in superimposed relationship: a) a core layer containing at least one cellulosic sheet impregnated with a thermosetting resin; and b) a first decorative layer consisting essentially of a leather material.

In the Office Action of 11/2/2006, the Examiner indicates that "a laminate comprising core sheets of kraft paper; a print sheet and an overlay sheet, both made of alpha-cellulose paper. The core sheets are impregnated with a phenol-formaldehyde resin, whereas the print or decorative sheet and the overlay sheet are impregnated with melamine-formaldehyde resin (See col. 1, ln. 55-71). The print sheet is with decorative printing, and is simulated leather (see col. 2, ln. 20-21), thus meeting the requirements of the presently claimed decorative layer." (page 5, 11/2/2006 Office Action). Applicants respectfully disagree with the Examiner's characterization of the '537 Patent, and the rejection based thereon.

Case law<sup>10</sup> dictates that the classic test for anticipation, under 35 U.S.C. §102(b), requires that every limitation in a claim must be present in a single source reference for that reference to "anticipate" the claimed invention. The '537 Patent cannot anticipate claim 1 because the '537 Patent does not disclose "a first decorative layer consisting essentially of a leather material" as is recited in claim 1.

The '537 patent discloses a high pressure laminate that includes an overlay sheet, a print sheet, and a plurality of core sheets. The overlay sheet is normally an alpha-cellulose sheet.<sup>11</sup> The print sheet is also "normally an alpha-cellulose paper, pigment filled, with or without decorative printing".<sup>12</sup> The core sheets are normally kraft paper.<sup>13</sup> The '537 Patent provides that it is desirable to have various types of irregular surfaces to "simulate wood grain, leather, slate, etc."<sup>14</sup> There is no

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<sup>10</sup> See generally Chisum, Patents, §§3.02, 3.02[1]. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379, 231 USPQ 81, 90 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987) ("It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention, and that such a determination is one of fact."); In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) ("It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim, and that anticipation is a fact question subject to review under the clearly erroneous standard.").

<sup>11</sup> See Col. 1, lines 55-56.

<sup>12</sup> See Col. 1, lines 61-63.

<sup>13</sup> See Col. 1, lines 67-71.

<sup>14</sup> See Col. 2, lines 19-22.

disclosure or suggestion within the '537 Patent of a print sheet or any other sheet comprising a leather material.

As stated above, claim 1 recites a heat and pressure consolidated laminate that includes a first decorative layer consisting essentially of a leather material. The present application defines the term "leather" as being an "animal hide".<sup>15</sup> MPEP §2111.01 (I.) clearly states that "the words of a claim must be given their 'plain meaning' unless they are defined within the specification".<sup>16</sup> Such is the case here.

The significance of the definition of the term "leather" provided in the specification is considerable. The present application details: 1) the desirability of using a leather material with cabinetry and/or furniture (e.g., perception of quality, texture, smell, etc.);<sup>17</sup> 2) the disadvantages of historical applications where leather was utilized in furniture and/or cabinetry (e.g., difficult to attach, shrinkage and peel after attachment, limitations in size, etc.);<sup>18</sup> and 3) the advantages of the present invention (e.g., textures, resistant to shrinkage, smell of leather, etc.).<sup>19</sup> These distinctions illustrate well that a laminate including a "leather material" is clearly distinguishable from the prior art, including a high pressure laminate with a print sheet having a visual appearance intended to "simulate" leather.

In light of the foregoing, it is respectfully submitted that the rejection of claims 1-6 is not valid and it is respectfully requested that the aforesaid rejection be withdrawn and the claims allowed.

Regarding claim 3, in addition to the reasons provided above, applicants respectfully further submit that the '537 Patent cannot anticipate the laminate of claim 3 for at least the reason that the '537 Patent does not disclose a laminate having a decorative layer comprising bonded leather having a sheet thickness ranging from about 0.2 mm to about 4.0 mm. The term "bonded leather" is specifically defined in the present specification to mean a leather product that comprises leather shavings made from scrap and/or recycled leather. Since the classic test for anticipation, under 35 U.S.C. §102(b), requires that every limitation in a claim must be present in a single source reference for that reference to "anticipate" the claimed invention, applicants respectfully submit that the '537 Patent cannot anticipate claim 3. Applicants, therefore, respectfully

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<sup>15</sup> See paragraph 0017.

<sup>16</sup> See also *In re Alex Zletz*, 893 F.2d 319, 321 (CAFC 1989)

<sup>17</sup> For example, see paragraphs 0002 and 0009.

<sup>18</sup> For example, see paragraphs 0005 – 0009.

submit that the rejection of claim 3 is not valid and it is respectfully requested that it be withdrawn and claim 3 allowed.

3. Claims 7 and 22-33 are Not Obvious Over '978 Patent or the '537 Patent, in view of U.S. Patent 2,732,325 to Lindenfeiser (hereinafter "the '325 Patent") or U.S. Patent 3,589,974 to Albrinck (hereinafter "the '974 Patent"):

In the Office Action of 11/2/2006, the Examiner indicates that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed amounts of melamine-formaldehyde resin in the core sheets as disclosed by the '325 Patent or the '974 Patent within the laminate of either the '978 Patent or the '537 Patent to arrive at the invention recited within claims 7 and 22-33. Applicants respectfully disagree with the Examiner's characterization of the cited references, and the rejection based thereon.

When an application is submitted to the Patent and Trademark Office, statute<sup>20</sup> and case law<sup>21</sup> dictates that the burden of proof is on the PTO to establish a *prima facie* case of obviousness.<sup>22</sup> Once the *prima facie* case has been established, then the burden of going forward with the evidence to rebut the *prima facie* case shifts to the applicant.<sup>23</sup> Only the burden of going forward with evidence to rebut shifts to the applicant, however. The burden of persuasion remains with the PTO.<sup>24</sup> In this instance, a *prima facie* case would necessarily have to first establish that the invention recited within claims 7 and 22-33 is found within the combined teachings of the cited references, and secondly that there is a suggestion or motivation to combine the references in the manner proposed by the Examiner to arrive at the claimed invention.<sup>25</sup>

Independent claim 7 recites a heat and pressure consolidated laminate that includes a first decorative layer consisting essentially of a bonded leather material having a sheet thickness ranging

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<sup>19</sup> See paragraphs 0005 – 0009.

<sup>20</sup> 35 U.S.C. 132.

<sup>21</sup> See *In re Warner*, 154 USPQ 173, 178 (C.C.P.A. 1967); *In re Oetiker*, 24 USPQ 2d 1443, 1447 (Fed. Cir. 1992).

<sup>22</sup> *In re Piasecki*, 223 USPQ 785, 788 (Fed. Cir. 1984).

<sup>23</sup> *In re Carleton*, 202 U.S.P.Q. 165,168 (CCPA 1979).

<sup>24</sup> *Ashland Oil v. Delta Resins and Refractories, Inc.*, 227 U.S.P.Q. 657, 659 (Cir. Fed. 1985). See also *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Cir. Fed. 1992): "In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. '[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.' The patent applicant may then attack the Examiner's *prima facie* determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness."

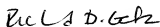
<sup>25</sup> *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979) citing *In re Bozek*, 163 USPQ 545, 549-550 (C.C.P.A. 1969).

from about 0.2 mm to about 4.0 mm. Independent claims 26 and 33 each recite a heat and pressure consolidated laminate that includes a first decorative layer consisting essentially of a leather material. As shown above, neither the '978 Patent nor the '537 Patent disclose or suggest a laminate that includes a leather material. In the case of claim 7, neither the '978 Patent nor the '537 Patent disclose or suggest a laminate that includes a bonded leather material. Neither the '325 or the '974 patents disclose or suggest a laminate that includes a leather material, or more specifically a bonded leather material. The combination of the cited references, therefore, does not disclose the elements recited within claims 7 and 22-33, and there is no suggestion by the Examiner that the references may be modified to provide the missing elements. Consequently, the proposed combination cannot establish the *prima facie* case of obviousness necessary to sustain the rejection.

In light of the foregoing, it is respectfully submitted that the rejection of claims 7 and 22-33 is not valid and it is respectfully requested that the aforesaid rejection be withdrawn and the claims allowed.

Please charge our deposit account No. 50-3381 in the amount of \$1,490.00 for the RCE fee and extra claim fees. If there are any additional fees due in connection with the filing of this appeal brief, please charge them to our Deposit Account 50-3381. If a fee required for any extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should be charged to the above Deposit Account.

Respectfully submitted,



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